

Application 09/866,652      Appeal 2007-0366      Technology Center 3600

**SUBMISSION OF AMENDMENT TO THE CLAIMS  
UNDER 37 CFR 41.50(b) REOPENING PROSECUTION**

**A.    Review of Decision *in re* Tommaso Innocenti**

***35 U.S.C. Section 112***

1.    Appellant respectfully submits that the Board:
  - a.    decided for Appellant in regard to the definiteness of base claim 40:  
      "we find for the Appellant and hold that claim 40 is definite" (p. 6);
  - b.    identified language from the present specification comprising a  
      limitation overcoming the indefiniteness of the phrase, 'may choose' in  
      claims 53, 54, 57, 59, 60 and 63: "From Appellant's specification it  
      appears that Appellant may have intended the limitation 'may choose'  
      to mean 'is presented with a choice to select.'" (p. 7).

***35 U.S.C. Section 103(a)***

2.    Appellant respectfully submits that the Board found for the Examiner  
in regard to the issue of Lerner comprising prior art but found for the  
Appellant in regard to rejection in view of Lerner and Moshal: "We do not  
find that the combination of Lerner and Moshal teaches the imitations  
directed to providing the option of provision of a model and providing the  
option of provision of a sample as claimed." (p. 12) and hence while Lerner  
is prior art, the Board finds:

for the Appellant on this issue and will not sustain the Examiner's  
rejection of independent claim 40 and dependent claims 41, 43, 46,  
through 49, 52 through 54, 56, 57, 59, 60, 62 and 63 which are  
similarly rejected over the combination of Lerner and Moshal. (p. 13)

Application 09/866,652      Appeal 2007-0366      Technology Center 3600

**SUBMISSION OF AMENDMENT TO THE CLAIMS  
UNDER 37 CFR 41.50(b) REOPENING PROSECUTION - p. 2**

3. Appellant respectfully submits that the Board found for Appellant in regard to "Examiner's rejections under 35 U.S.C. Section 103(a) of dependent claims 42, 44, 45, 50, 51, 55, 58, 63 through 76." (p. 14) because:

As we have found that the combination of Lerner and Moshal does not teach all of the limitations of independent claim 40, the third issue is do the other documents recited in the Examiner's other rejections under 35 U.S.C. Section 103(a) teach the missing limitations. As discussed *supra*, we do not find that the passages cited by the Examiner in either the Microsoft Computer Dictionary, or Auction This article, teach or suggest provision of a sample or a model in an online auction. Further, we do not find that either Conklin or Thomas teaches or suggests a buyer providing models of a commodity to indicate to a seller the quality desired. (pp. 13-14)

**35 U.S.C. Section 101**

4. Appellant respectfully submits that the Board entered a new ground of rejection of claims 40 through 76 under 35 U.S.C. 101 as set forth in pages 14 through 17 replete with a number of judicial citations including *Corning v. Burden*: "It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . ." further stating that to satisfy 101 requirements "the claim must be for a practical application of the Section 101 judicial exception" including transformation "of an article or physical object to a different state" or producing "a useful, concrete and tangible result" (p. 17).

Application 09/866,652

Appeal 2007-0366

Technology Center 3600

**SUBMISSION OF AMENDMENT TO THE CLAIMS  
UNDER 37 CFR 41.50(b) REOPENING PROSECUTION – p. 3**

5. Appellant respectfully submits that while the Board concludes that no transformation is wrought by the presently claimed invention, at least partly because "transfer of ownership, (is) a legal abstraction, and does not require the transfer of physical possession" (p. 17), and although physical transfer of possession is implied by provision of a sample or model, the Board does "not find that a physical transformation of the sample or model occurs" (p. 18), still, "(T)he enquiry into whether a claim fails the statutory requirement of 35 U.S.C. 101, does not end because it is determined that (the) there is no transformation or reduction of an article to a different thing or state." as "it must (still) be determined if the claim provides a practical application that produces a useful, tangible and concrete result." (p.18).

6. Appellant respectfully submits that while the Board finds "no tangible result from the claimed method" it is further acknowledged by the Board that the Federal Circuit, reciting *State Street Bank*, also has held that:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to ... but on the essential characteristics of the subject matter, in particular its practical utility. (p.19)

continued

Application 09/866,652      Appeal 2007-0366      Technology Center 3600

**SUBMISSION OF AMENDMENT TO THE CLAIMS  
UNDER 37 CFR 41.50(b) REOPENING PROSECUTION – p. 4**

***Conclusion***

7. Appellant respectfully submits that the Board, with regard to rejection under 35 U.S.C. 112(b), sustains the rejection of claims 53 through 64 but reverses the rejection of claims 40 through 52 and 65 through 76 as considered to be in error and similarly find "Examiner's rejections of claims 40 through 76 under 35 U.S.C. 103(a) to be in error as":

we do not find that the combination of the references cited by the Examiner teach or suggest providing on a web site, a proposal format which allows a buyer of a commodity to specify a type of auction and present the buyer with an option which allows the buyer to provide a model indicating the quality desired as claimed. (pp. 19-20); and

further the Board enters new grounds of rejection of claims 40 through 76 under 35 U.S.C. 101 pursuant to 37 C.F.R. 41.50(b) which section further provides that these new grounds "shall not be considered final for judicial review" and that Appellant must, within two months of the date of the decision, either:

- (1) reopen prosecution with submission of either appropriate amendment to the claims rejected or new evidence relating thereto, or both, for reconsideration by Examiner; or
  - (2) request a rehearing by the Board upon the same record; and
- whereby the "decision of the examiner rejecting claims 40 through 76 is Affirmed-in-Part." (p. 21)

continued

Application 09/866,652      Appeal 2007-0366      Technology Center 3600

**SUBMISSION OF AMENDMENT TO THE CLAIMS  
UNDER 37 CFR 41.50(b) REOPENING PROSECUTION – p. 5**

**B. Submission of Amendment Overcoming Grounds of Rejection**

***Claim Language***

1. Appellant respectfully submits that an inadvertent error in present claim 40: repetition of the word "desired" instead of "offered" in description of a prospective seller's sample, inadvertently repeating language used to describe a prospective buyer's model; is corrected by the present amendment.
2. Appellant respectfully submits that the grounds of the only appealed rejection sustained by the Board: that of claims 53 through 64 under 35 U.S.C. 112, second paragraph:

We consider the Examiner's rejection of 53 through 64 under 35 U.S.C. Section 112, second paragraph to be proper and sustain this rejection. However, we consider the Examiner's rejection of claims 40 through 52, and 65 through 76 under 35 U.S.C. Section 112, second paragraph, to be in error and we reverse this rejection. Similarly, we consider the Examiner's rejections of claims 40 through 76 under 35 U.S.C. Section 103(a) to be in error as we do not find that the combination of the references cited by the Examiner teach or suggest providing on a web site, a proposal format which allows a buyer of a commodity to specify a type of auction and present the buyer with an option which allows the buyer to provide a model indicating the quality desired as claimed. (pp. 19-20);

are overcome by the present amendment in replacement of the phrase "may choose", in claims 53, 54, 57, 60, and 63, with language identified by the

Application 09/866,652      Appeal 2007-0366      Technology Center 3600

**SUBMISSION OF AMENDMENT TO THE CLAIMS  
UNDER 37 CFR 41.50(b) REOPENING PROSECUTION – p. 6**

Board: "is presented with a choice to select" (p. 7); in comprising a limitation from the specification comprised of definite language correctly surmised by the Board as that intended by the indefinite original claim phrasing.

***Claimed Subject Matter – 35 U.S.C. Section 101***

3. Appellant respectfully submits that the present amendment overcomes the grounds of rejection under 35 U.S.C. 101 by clarifying that the invention claimed provides for the conduct of an auction with a transformation of the state of physical goods: from possession by one party to possession by another party; and hence a useful, concrete, tangible result: sale of a lot of commodities under the terms, inclusive of delivery and payment, negotiated during the auction.

4. Appellant respectfully submits that the present amendment clarifies the presently claimed subject matter as one providing a useful, concrete and tangible result by clearly expressing the originally intended claimed subject matter as a judicially recognized exception to non-statutory subject matter under 35 U.S.C. 101, as opposed to an abstraction lacking "transformation or conversion of subject matter representative of or constituting physical activity or objects." (*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, reciting from *In re Schraeder*, 22 F.3d, 30 USPQ2d 1455 (Fed. Cir. 1994))

Application 09/866,652      Appeal 2007-0366      Technology Center 3600

**SUBMISSION OF AMENDMENT TO THE CLAIMS  
UNDER 37 CFR 41.50(b) REOPENING PROSECUTION – p. 7**

5. Appellant respectfully submits that the present amendment overcomes the new grounds of rejection under 35 U.S.C. 101 by making explicit in base claim 40 the originally intended but originally implicit conduct of an auction by:

- a. deleting the word "business" preceding, and replacing "intended to facilitate" with 'enabling' after, the word "method", and inserting 'by auction' in between "trading" and "comprising" all in the preamble;
- b. inserting 'conducting a commodities auction by' in between the phrases beginning with "providing the option of the provision of a sample" and "posting upon said web site a listing";
- c. inserting: (i) 'sale of said lot with', (ii) 'inclusive of delivery and payment', (iii) 'in accordance with said terms', in the last clause of said base claim;

whereby the conduct of an auction resulting in the change of possession of physical commodity, and stipulated transport of the commodity, originally implicit, is made explicit in claim 40 now drawn clearly to transformation of the state of physical objects: the change of possession by sale through auction conducted in accordance with the claimed method.

6. Appellant respectfully submits that the present amendment makes explicit the auction including sale and stipulated transport of physical commodity by the claimed method hence overcoming the grounds of rejection thereof under 35 U.S.C. 101 for lack of a "tangible result" (p. 19).

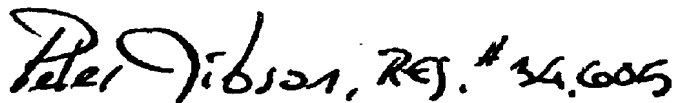
Application 09/866,652      Appeal 2007-0366      Technology Center 3600

**SUBMISSION OF AMENDMENT TO THE CLAIMS  
UNDER 37 CFR 41.50(b) REOPENING PROSECUTION – p. 8**

**C. Summary and Request for Allowance**

1. Appellant respectfully submits that the present amendment overcomes the grounds of the sole appealed rejection, under 35 U.S.C. 112 second paragraph of claims 53 through 64, sustained by the Board.
2. Appellant respectfully submits that the present amendment overcomes the grounds of the rejection under 35 U.S.C. 101 introduced by the Board by making explicit the 'tangible result' originally implicit in the sole base claim.
3. Appellant respectfully submits that the present reply inclusive of amendment: overcomes the grounds of all outstanding rejection, has been timely filed, is believed to eliminate all instances of indefinite language in the claims, is in full accordance with the Rules inclusive of 37 C.F.R. 41.50(b), and that no objections to the present application are outstanding.
4. Appellant respectfully submits, for all the reasons set forth above, that the present application is in full and proper condition for allowance which action is further respectfully and humbly requested.

Respectfully yours,



Peter Gibson, Reg. #34,605

Telephone, Facsimile: 39 0564 93 6500